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10/618,274

07/11/2003

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05/17/2006

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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,274

Applicant(s)

BLAKELY ET AL.

Examiner

Tae H. Yoon

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 40-58 is/are pending in the application.
- 4a) Of the above claim(s) 40-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's election with traverse of Group I, claims 1-19, in the reply filed on 28 February 2006 is acknowledged. The traversal is on the ground(s) that the search for Group III is not undue search burden. This is not found persuasive because The Group III (claim 40) recites the amount of titanium being 0.0 to 5 ppm (defined in the specification as absence of), but the Group I recites "substantially free of a titanium" encompassing more than 5 ppm. Also, the search for the Group III further requires classes 524 and 528 in addition to classes 523 and 528 for group I.

The requirement is still deemed proper and is therefore made FINAL.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of

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copending Application No. 10/855,723 (US 2005/0008885 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant UV inhibitor encompasses that of said copending Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Improper Markush language is recited in claim 1. Insertion of "and" before manganese of claim 1 is needed.

The recited "or more components" in claim 19 improperly broadens the scope of claim 14 wherein "a component" is recited.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The claims 1-19 are not commensurate in scope with an enabling disclosure until the named groups for "substituted" for R³ in claim 1 as described in the instant

specification, are recited in the claims for "substituted". If there are no examples for "substituted", in the instant specification, "substituted" must be cancelled because the specification is not enabling for the skilled artisan to practice the invention. It would require undue experimentation to determine all of the groups which are encompassed by "substituted" and how to attach these groups to the claimed compound.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pruett et al (US 4,617,374), Pruett et al (US 5,459,224), Carman et al (US 6,001,952) or Weaver et al (US 6,787,589) in view of Fujimori et al (US 6,703,474) and JP407258393A.

Pruett et al (abstract, table and example 24), Pruett et al (abstract and claims 1-12), Carman et al (abstract, examples 8 and claims 1-17) or Weaver et al (abstract and claim 10) teach the instant polyester having reacted UV inhibitor.

The instant invention further recites utilization of a multi-stage pressure reaction apparatus and various catalysts over Pruett et al, Pruett et al, Carman et al and Weaver et al. However, said utilization of a multi-stage pressure reaction apparatus in obtaining polyesters is well known as taught by Fujimori et al (col. 13, line 16 to col. 14, line 9 and example 1-1; conversion of units meets the instant invention). Said example 1-1 shows

the use of magnesium acetate tetrahydrate over the instant manganese compound, but Fujimori et al teach and equate said magnesium (Group IIA metal) and manganese compounds at col. 12, line 45. The molar ratio of a diol and a diacid is taught at col. 13, lines 9-12. Fujimori et al also teach employing other metals such as iron or cobalt in order to suppress elution of antimony at col. 8, lines 41-47.

JP teaches employing a catalyst system of manganese compound, phosphorus compound and antimony compound in abstract.


It would have been obvious to one skilled in the art at the time of invention to utilize the multi-stage pressure reaction apparatus and catalyst system of manganese compound, phosphorus compound and antimony compound with iron or cobalt taught by Fujimori et al (such as example 1-1 with varying pressures taught at col. 13, line 60 to col. 14, line 9) and JP in making the UV inhibitor reacted polyesters of Pruett et al, Pruett et al, Carman et al and Weaver et al since it is well known in the art that said multi-stage pressure reaction method would provide a better control on molecular weights and yield as taught by Fujimori et al and since a catalyst system of manganese compound, phosphorus compound and antimony compound is well known as taught by JP.

Claim 9 further recites 0.0 ppm titanium metal over 2 ppm of example 1-1 of Fujimori et al, but Fujimori et al teach and equate titanium compound and zinc compound at col. 18, lines 49-66. Thus, the utilization of said zinc compound over said titanium compound in example 1-1 of Fujimori et al would yield 0.0 ppm titanium metal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/May 15, 2006